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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/248,524	02/09/1999	AMIT R. SHAH	2870/72	8887

7590 07/24/2003

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EXAMINER	
WELLS, LAUREN Q	

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 07/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N. 09/248,524	Applicant(s) SHAH, AMIT R.	
	Examiner Lauren Q Wells	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 May 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *30*.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claims 1-22 are pending. Applicant's arguments are persuasive to overcome the 35 USC 112, 1st paragraph rejection in the previous Office Action, and persuasive-in-part to overcome the 35 USC 112, 2nd paragraph rejections in the previous Office Action (see below for details).

Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/15/03 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The term "long wearing" in claims is a relative term which renders the claim indefinite. The term "long wearing" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Regarding this rejection, Applicant

argues, "the term 'long-wearing' is clear and concise. This was in response to the Examiner's assertion that the term is not defined by a lower limit in the claims or specification. However, it is inherent that that the lower limit of a composition that is long-wearing is irrelevant". This argument is not persuasive. Does long wearing mean that it lasts for 48 hours, for 2 hours, for 2 minutes? Applicant argues, "What is reasonable known and understood by one of ordinary skill in the art upon reading the present specification is that the compositions of the present invention are 'long wearing' when the compositions are on the skin for up to a full day". This argument is not persuasive, as Applicant has provided no evidence that this term is routinely defined in the art in this manner. Applicant argues that this term is found in other claims of allowed patents. This argument is not persuasive. The Examiner respectfully points out that the prosecution of every Application is distinct. Thus, what is allowed or not allowed in one application has no bearing on the instant application.

(ii) The term "derived" in claims 1, 10, and 22 is vague and indefinite, as the metes and bounds of this claim are unascertainable. For example, what is an acrylic acid derived polymer? Does the polymer even comprise acrylic acid? What chemical attributes are defined by the term "derived"? This rejection can be overcome by deleting the term "derived" from the claims. Regarding this term, Applicant argues, "Applicants are not required to describe that which is known by one of ordinary skill in the art". This argument is not persuasive, as Applicant has not provided any evidence that these term are known by those of ordinary skill in the art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-15, 17, 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valdes et al. (4,761,277) in view of Alwattari et al. (5,874,072).

The instant invention is directed toward a composition comprising a polymer component selected from acrylic acid derived polymer, acrylic acid derived copolymer, acrylic acid ester derived polymer, acrylic acid ester derived copolymer, a methacrylic acid derived polymer, a methacrylic acid derived copolymer, a methacrylic acid ester derived polymer, and a methacrylic acid ester derived copolymer, and at least one water soluble organic pigment.

Valdes et al. teach a waterbase lipliner composition in the form of a liquid for use in conjunction with a wick-type nib pen, wherein the composition includes a water-soluble organic pigment, a water-soluble organic polymer film-former, which is a mixture of polyvinylpyrrolidone and polyvinyl alcohol, optional ingredients, and water as a carrier for the pigment. FD&C Yellow 5 is specifically taught as a water-soluble organic pigment. The pigment comprise, preferably, 0.1-5% of the composition. A method of making the composition is taught, wherein the all the ingredients are mixed together. The reference lacks polymeric components. See Col. 1,lines 11-62; Col. 3, lines 15-19; Col. 4, lines 5-37.

Alwattari et al. teach water-insoluble polymeric materials in the form of an aqueous emulsion and water soluble, film-forming polymers. Ammonium acrylate is taught as a preferred water-insoluble polymeric material that in combination with water-soluble film forming polymers, provides compositions that have superior wear and are removable with soap and water. These polymeric materials are taught as comprising 3-60% of a composition. A

method of making the composition is taught, wherein the all the ingredients are mixed together. See Col. 1, line 66-Col. 2, line 66.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the ammonium acrylate, taught by Alwattari et al., into the composition of Valdes et al. because of the expectation of achieving a cosmetic product that has superior wear and is removable with soap and water.

Regarding claim 22, it is respectfully pointed out that the intended use of the method of making a composition is not given patentable weight.

Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valdes et al. in view of Alwattari et al. as applied to claims 1-15, 17, 19-22 above, and further in view of Burdzy (5,518,728).

Valdes et al. and Alwattari et al. are applied as discussed above. The reference lacks eyeliners.

Burdzy teaches cosmetic compositions for non-white pigmented skin. Eyeliners and lipliners are taught as interchangeable cosmetic composition forms. See Col. 10, lines 58-65.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the combined references in the form of an eyeliner because Burdzy teaches eyeliners and lipliners as interchangeable cosmetic forms.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
June 24, 2003

SREENI PADMANABHAN
PRIMARY EXAMINER 6/26/03